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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/714,144	11/17/2000	Yosuke Hoi	0505-0714P	5531

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EXAMINER
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BURCH, MELODY M

ART UNIT	PAPER NUMBER
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3683

DATE MAILED: 01/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/714,144

Applicant(s)

HOI ET AL.

Examiner

Melody M. Burch

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1) ☒ Responsive to communication(s) filed on 14 October 2003.

2a) ☐ This action is FINAL.

2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4) ☒ Claim(s) 1,3-6,9,11,12 and 14-17 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) ☒ Claim(s) 9 and 11 is/are allowed.

6) ☒ Claim(s) 1,3-6,12 and 14-17 is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some \* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.

4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 6 and 17 are objected to because of the following informalities: in line 3 of claims 6 and 17 the phrase "a oil" should be changed to --an oil-- for grammatical purposes. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 4, 5, 15, and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Re: claims 4 and 15. The phrase "parallel to said main gallery and shorter transverse part" first claimed in lines 11-12 from the bottom is indefinite since the language reads as if the longer longitudinal part is parallel to the shorter transverse part as well as the main gallery. Examiner recommends using such language as --said L-shaped body including a shorter transverse part and a longer longitudinal part parallel to said main gallery-- to avoid confusion or misinterpretation. A similar problem exists in claim 15. Claims 5 and 16 are indefinite due to their dependency from one of claims 4 and 15.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 3-5, 12, and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP-988523 (JP '523) in view of US Patent 4086981 to Mitsui.

Re: claims 1 and 12. JP '538 shows in figure 3 a lubricating apparatus capable of being used for a horizontally disposed dry sump engine, comprising: a cylindrical relief valve 78, the cylindrical relief valve having a longitudinal axis disposed in a horizontal direction, the longitudinal axis being disposed in parallel to a longitudinal axis of a main gallery shown in the area of the lead line of element number 50 and a horizontal longitudinal axis of a crank shaft 4 of the engine. It is noted that the crank shaft 4 is shown in figure 1 to be disposed in parallel to the shaft 14 which is shown in figure 3 to be disposed in parallel to the relief valve 78 and the main gallery shown in the area of element number 50.

JP '538 shows in figure 3 the relief valve having a body with a longer longitudinal part parallel to the main gallery and an end of the body being in communication with the main gallery via the passage shown in the area of the lead line of number 72a, but does not show or disclose the limitation of the relief valve having an L-shaped body with a longer longitudinal part and a shorter transverse part connected at one end to an in communication with the main gallery.

Mitsui teaches in figure 1 the use of a valve having an L-shaped body 4 including a longer longitudinal part shown in the area of elements 16,18,4b and a shorter transverse part shown in the area of elements 2,4a.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the valve body shape of the relief valve of JP '538 to have been an L-shaped body including a shorter transverse part, as taught by Mitsui, in order to provide a means of helping to guide fluid directly into the relief valve and prevent excessive leakage of the lubricating fluid via the slot shown in the area of the lead line of number 80 between the main gallery and the relief valve body.

Re: claims 3, 5, and 14. JP '538, as modified as set forth in claim 1, teaches in figure 3 of JP '538 the use of a discharge port shown in the area to the right of the lead line of number 78.

Re: claims 4, 15, and 16. JP '538, as modified as set forth in claim 1, teaches in figure 3 of JP '538 the use of a stopper or shoulder shown to the left of the lead line of number 80 and to the right of the discharge port for restricting movement of the cylindrical valve body shown in the area of the lead line of number 78 in the longer longitudinal part, a spring shown within the cylindrical valve body for biasing the cylindrical valve body toward the stopper, a spring stop shown to the right of the lead line of number S2 for pressing the spring, and a mounting portion or threads integrally formed with the L-shaped body shown in the area of the lead line of number 2 shown in figure 1 of Mitsui for mounting the relief valve, as modified to a bottom wall portion of the main gallery via passage 72a.

6. Claims 6 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP-988523 (JP '523) in view of US Patent 4086981 to Mitsui as applied to claims 1 and 12 and further in view of US Patent 5339446 to Regueiro.

JP '538, as modified, shows the use of an oil tank 6a, but does not show the limitation of a strainer, the strainer being provided in the oil tank.

Regueiro teaches in figure 1 the use of a lubricating apparatus comprising an oil tank 14 and a strainer 15 for straining oil recovered in the oil tank, the strainer being provided in the oil tank.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the oil tank of JP '538, as modified, to have included a strainer being provided in the oil tank, as taught by Regueiro, in order to provide a means of separating debris from the oil of the lubrication apparatus.

#### ***Allowable Subject Matter***

7. Claims 9 and 11 are allowed. JP-988523 (JP '523) alone or as modified fails to teach or suggest the limitation of a relief valve provided in the oil tank.

#### ***Response to Arguments***

8. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melody M. Burch whose telephone number is 703-306-4618. The examiner can normally be reached on Monday-Friday (7:30 AM-4:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Lavinder can be reached on 703-308-3421. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9326.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

*mmb 12/31/03*  
mmb  
December 31, 2003

*M. L. [Signature]*  
*1/6/2004*  
MATT  
PRIMARY EXAMINER  
GROUP 310